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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,662	03/31/2004	Naoki Naruse	9683/183	5965
757 7590 09/04/2007 BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			EXAMINER POLTORAK, PIOTR	
			ART UNIT 2134	PAPER NUMBER
			MAIL DATE 09/04/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/814,662

Applicant(s)

NARUSE ET AL.

Examiner

Peter Poltorak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date 9/04 and 5/07.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-6 have been examined.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan No. 2003-096088 filed on 03/31/03.

Drawings

3. The drawings are objected to because drawings do not disclose "hard disk device 12A" discussed in the specification (paragraphs 31, 34 etc.). Similarly "hard disk device 18A" of a trusted server device 18 recited in paragraph 36, for example, is not shown in any of the figures.
4. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion

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of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities:

Appropriate correction is required.

Oath/Declaration

6. The title of the invention is missing in the declaration and as result it is not clear to which application does the declaration refer.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 6 is directed to an abstract idea: a program for instructing a computer. In order to meet the patentability XXX a program must be comprised on a computer readable medium, wherein the computer readable medium is clearly indicated to be a hardware element, e.g. a computer memory, disk etc. The program should also

perform steps that provide some useful tangible results. Although the program recited in claim enables implementation of receiving, calculating, comparing and determining validity there is no tangible outcome of determining validity of "correspondence of said first file and said second file according to a result of the comparison made in said comparing step".

8. Although claim 1 comprises functional elements (a calculating means, a comparing means and a determining means) there is no tangible and useful result of these functional elements.

Claim Objections

9. Claims 1-6 are objected to because of the following informalities: although claim language is interpreted in light of the specification, the claim language should be unambiguous. Claims 1 and 6 do not clearly articulate the meaning of the recited limitations. For example the statement: "a first file which contains data indicating a certain value which is calculated on the bases of ..." in 1 (a) does not clearly indicate the claimed subject matter. It is not clear whether it is data or a certain value that is calculated. Similar ambiguity is observed in claim 6 (a).
10. Additionally, claims 1 and 6 appear to be a literal translation into English from a foreign document. Applicant is suggested to rewrite the claims in more clear form.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 and 6 recite "a receiving means" but the specification does not provide disclosure what the receiving means consist of (e.g. antenna, a program routine, communicating unit, combination or all of the elements).

12. Claims 2-5 are rejected by virtue of their dependence.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The specification lacks corresponding structure as required by 35 U.S.C. 112, sixth paragraph, and fails to comply with 35 U.S.C. 112, second paragraph. See 35 U.S.C. 112 first paragraph rejection above.

14. Also, claim 1 is directed toward a communication device. However, it is not clear what elements represent "receiving means" and, as a result, it is not clear how/whether the recited elements of claim 1 support the preamble.

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15. Claims 2-5 are rejected by virtue of their dependence.

Appropriate correction is required.

Claim Rejections - 35 USC § 102 or 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1-3 and 6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schneier (Bruce Schneier, "Applied Cryptography, Protocols, Algorithms and Source Code in C", 2nd edition, 1996 ISBN: 0471128457).

As per claims 1 and 6, Schneier discloses receiving a first file (one-way hash) which contains data indicating a certain value which is calculated on the basis of data of a certain type in another file (a document), and a second file (the document) which contains data of said certain type, calculating step for calculating a value (one-way hash) which is obtained for assigning said data of said certain type contained in said second file to a one-way function, comparing step for comparing the value which is

calculated in said calculating step and said certain value indicated by said data contained in said first file and a determining step for determining validity of correspondence of said first file and said second file according to a result of the comparison made in said comparing step (comparing hash, Schneier pg. 38 "Signing Documents with Public-Key Cryptography and One-Way Hash Functions).

17. The examiner also points out that an ordinary artisan would readily recognize that the discussed above method is implemented on a computer using computer programs.

18. The limitation of claim 2 is at least implicit: providing non complete either first or second file would result in incorrect calculation, since hash of a file is unique for the particular file.

19. As per claim 3, the hash is signed with a file provider's private key and private keys uniquely identify the key owner.

20. Claims 1-6 are rejected under 35 U.S.C. 103(a) as obvious over Rose (USPN 5708709) in view of Schneier (Bruce Schneier, "Applied Cryptography, Protocols, Algorithms and Source Code in C", 2nd edition, 1996 ISBN: 0471128457). Rose teaches receiving a first file (the Transmission Format of an application program file), which contains data of certain type and a second file (comprising an Application Program) which contains data of said certain type (Fig. 3, col. 4 lines 31-35 and 59-68).

21. Rose does not disclose that the first file contains data indicating a certain value which is calculated on the basis of data of, calculating a value which is obtained for

assigning said data of said certain type contained in said second file to a one-way function, and comparing step for comparing the value which is calculated in said calculating step and said certain value indicated by said data contained in said first file and determining validity of correspondence of said first file and said second file according to a result of the comparison made in said comparing step.

Schneier discloses receiving a first file first file contains data indicating a certain value which is calculated on the basis of data of, calculating a value which is obtained for assigning said data of said certain type contained in said second file to a one-way function, and comparing step for comparing the value which is calculated in said calculating step and said certain value indicated by said data contained in said first file and determining validity of correspondence of said first file and said second file according to a result of the comparison made in said comparing step (Schneier pg. 38 "Signing Documents with Public-Key Cryptography and One-Way Hash Functions).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include receiving a first file containing data indicating a certain value which is calculated on the basis of data of and calculating a value which is obtained for assigning said data of said certain type contained in said second file to a one-way function, and comparing the value which is calculated in said calculating step and said certain value indicated by said data contained in said first file, and determining validity of correspondence of said first file and said second file according to a result of the comparison made in said comparing step. as disclosed

by Schneier. One of ordinary skill in the art would have been motivated to perform such a modification in order to ensure integrity of the data indicating a certain value included in the first file.


22. As per claims 4-5, the second file comprises a program which runs in the communication device (see object 181, Fig. 3), the first file contains data indicating a condition for restricting behavior of an application which is realized when the program is run in the communication device (license terms, Fig. 3), and although Rose in view of Schneier do not disclose that the first second file indicates a location where a program which is run in the communication devices is stored, an ordinary artisan would readily recognize that the computer programs are referred by pointers (which reads on a location).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Poltorak whose telephone number is (571) 272-3840. The examiner can normally be reached Monday through Thursday from 9:00 a.m. to 4:00 p.m. and alternate Fridays from 9:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on (571) 272-3811. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


8/24/07
KAMBIZ ZAND
SUPERVISORY PATENT EXAMINER